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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,469	03/21/2006	Atsushi Ogawa	090358	8944
23850 7590 01/19/2011 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. 4th Floor WASHINGTON, DC 20005				
EXAMINER				
OU, JING RUI				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
01/19/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/541,469

**Applicant(s)**

OGAWA ET AL.

**Examiner**

JING RUI OU

**Art Unit**

3773

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11, 12, and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to the amendment filed on 10/19/2010. Claims 1-5 and 8-14 are pending. Claims 1 and 11 are independent. Claims 6 and 7 have been cancelled. Claims 13 and 14 are newly added. Claims 8-10 are withdrawn. Claim 13 is withdrawn by the examiner for the reason stated below.

#### ***Election/Restrictions***

2. Newly submitted claim 13 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 13 is directed to the non-elected species (Figs. 3 and 4).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 13 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Objections***

3. Claims 1-5, 12, and 14 are objected to because of the following informalities: In line 6 of claim 1, the phrase "in a case that" should be deleted since species A (Figures 1 and 2) is being examined. In claim 14, "a coil separating member" should be corrected to "the coil separating member" in line 2 of the claim.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5, 12, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the dry stretch suppressing member" in line 6 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the wire" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 4, 5, 11, 12, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Martinez (US Pub. No. 2004/0098028).

In regard to claims 1, 2, 4, 5, 11, 12, and 14, Martinez discloses an embolus forming in-vivo indwelling device (10) comprising a coil separating member (16) and a coil main body (13) having flexibility and a stretch suppressing member (12) which is provided on an inner periphery of the coil main body and which is made of a polyvinyl alcohol polymer (Para. [0023]); wherein the stretch suppressing member is provided on the inner periphery of the coil main body (Figs. 1-2), the stretch suppressing member

has a smaller diameter than the coil diameter of the coil main body (Figs. 1-2), and the stretch suppressing member enters space between adjacent wire turns of the coil main body as a result of the swelling (Figs. 3-4); wherein the coil main body has a coil diameter of 0.25 mm (Para.[0039]); wherein the stretch suppressing member has a rod-like shape or cylindrical shape and is provide in the coil main body so as to pass through the coil main body and extend in the coil axial direction of the coil main body (Para. [0022]); Wherein the diameter of the stretch suppressing member is smaller than the inner diameter of the coil main body by about 1 to 50% in a dry state (Figs. 1-2 and Para. [0039]); wherein the coil main body has space between each turn before swelling (Figs. 1-2); wherein the coil separating member is partially provided inside the coil body in a state that a distal end of the coil separating member is in contact with a proximal end of the stretch suppressing member (Figs. 2 and 4).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez (US Pub. No. 2004/0098028) as applied to claim 3 above, and further in view of Wallace et al (US Pub. No.: 2002/0151926).

In regard to Claim 3, Martinez discloses all the limitations of the claim as taught above but does not appear to disclose that the wire constituting the coil main body has a diameter of 10 to 120  $\mu\text{m}$ , a coil length of 2 to 500 mm and a number of turns of 1 to 100 per unit length (1mm). However, Wallace et al discloses a vaso-occlusive coil comprising a wire that constitutes the coil main body has a diameter of 12.7 mm to 152.4 mm, a coil length of 24 to 400 mm and a number of turns of 1 to 7.5 per unit length (1mm) (Para.[0030]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coil of Martinez to include the dimensions of the coil with a wire that constitutes the coil main body has a diameter of 12.7 mm to 152.4 mm, a coil length of 24 to 400 mm and a number of turns of 1 to 7.5

per unit length (1mm) as taught by Wallace et al, since it has been held that that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-5, 11, 12, and 14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JING RUI OU whose telephone number is (571)270-5036. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, UYEN (JACKIE) HO can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. O./  
Examiner, Art Unit 3773  
01/13/2011

/Melanie Tyson/  
Primary Examiner, Art Unit 3773